**APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED DECEMBER 17, 2004**

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

04-1063, -1076
(Opposition Nos. 71,706, 72,817, 73,756, 74,517, 72,818, and 75,003)

SHEN MANUFACTURING CO., INC.,

Appellant,

v.

THE RITZ HOTEL LIMITED,

Cross Appellant.

DECIDED: December 17, 2004

Before MAYER, *Chief Judge*, SCHALL and PROST, *Circuit Judges*.

MAYER, *Chief Judge*.

Shen Manufacturing Co., Inc. ("Shen") appeals the decision of the Trademark Trial and Appeal Board, which dismissed Shen's oppositions to The Ritz Hotel, Limited's ("RHL") registration of: (1) PUTTING ON THE RITZ for shower curtains; (2) RITZ PARIS RITZ HOTEL and design for various items of dinnerware; and (3) RITZ PARIS RITZ

*Appendix A*

HOTEL and design for various floor and wall coverings. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, Opposition Nos. 71,706, 73,756 and 74,517, respectively (TTAB Aug. 7, 2003) ("*Board's Opinion*"). RHL cross-appeals the board's decision sustaining Shen's opposition to RHL's registration of RITZ for cooking and wine selection classes and THE RITZ KIDS for ready-made and tailored clothing. *Board's Opinion*, Opposition Nos. 72,818 and 75,003, respectively. We affirm the board's dismissal of Opposition Nos. 71,706, 73,756 and 74,517; and reverse the board's decision sustaining Opposition Nos. 72,818 and 75,003.[1]

*Background*

RHL owns and operates The Ritz Hotel in Paris, France, which was opened in 1898 by Cesar Ritz. According to RHL, as well as a myriad of publications presented by RHL, The Ritz Hotel is one of the most luxurious and renowned hotels in the world. Aside from hotel and restaurant services, RHL has expanded into other industries, including the sale of coffee, tea, chocolates, drinking glasses and champagne. These products are sold under a variety of registered marks, such as RITZ, RITZ PARIS RITZ HOTEL and design, and HOTEL RITZ. Shen, on the other hand, sells kitchen textiles, such as dish towels, potholders, and aprons, in addition to a variety of other textile items including bathroom towels and ironing board covers. Shen has used the RITZ mark, which was derived from its founder's last name, John Ritzenthaler, since it began doing business in 1892.

1. Shen also appealed the board's dismissal of Opposition No. 72,817. Because RHL has abandoned the corresponding application, Shen's appeal is moot.

*Appendix A*

In 1984 and 1985, RHL applied to register the following marks: (1) PUTTING ON THE RITZ for shower curtains; (2) RITZ PARIS RITZ HOTEL and design for "dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, [and] household glassware"; (3) RITZ PARIS RITZ HOTEL and design for "carpets, rugs, floor mats and matting, linoleum for covering existing floors, [and] wall covering made of vinyl and plastic"; (4) RITZ for cooking and wine selection classes; and (5) THE RITZ KIDS for ready made and tailored clothing, including underwear, dresses, skirts, trousers, shirts, neckties, belts, gloves, hats, raincoats and galoshes. Shen opposed the registrations, arguing that RHL's use of "Ritz" would likely cause confusion based on three factors: (1) the strength of Shen's RITZ mark; (2) the similarity of RHL's marks to Shen's RITZ mark; and (3) the relatedness of the products covered by RHL's applications and those sold by Shen.

In 2003,[2] the board decided Shen's consolidated oppositions. The board dismissed Opposition No. 71,706, which challenged RHL's registration of PUTTING ON THE RITZ for shower curtains. In so doing, the board found that while shower curtains are closely related to Shen's products, namely bathroom towels, RHL's PUTTING ON THE RITZ mark is dissimilar to Shen's RITZ mark in terms of appearance, sound and commercial impression. The board likewise dismissed Opposition Nos. 73,756 and 74,517,

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2. RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward.

which challenged both of RHL's registrations of RITZ PARIS RITZ HOTEL and design. Again the board found that the goods described in RHL's applications were related to Shen's goods, but that the differences in the marks were sufficient to prevent any likelihood of confusion. In contrast, the board sustained Opposition No. 72,818 covering RITZ for cooking and wine selection classes, finding that there was a likelihood of confusion because cooking classes require the use of kitchen textiles. The board also sustained Opposition No. 75,003 regarding THE RITZ KIDS for clothing, finding that gloves are too related to barbeque mitts considering the similarity of the marks. Shen appealed the board's decision as to Opposition Nos. 71,706, 73,756 and 74,517; RHL cross-appealed the board's decision as to Opposition Nos. 72,818 and 75,003. We exercise jurisdiction pursuant to 28 U.S.C. § 1295(a)(4). *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1356 (Fed. Cir. 2000).

*Discussion*

We review the board's legal conclusions *de novo*, *In re Dixie Rest., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997), and its findings of fact for substantial evidence, *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1359 (Fed. Cir. 2001). Whether there is a likelihood of confusion is a question of law based on underlying facts, such as the similarity of the marks and the relatedness of the goods or services. *In re Dixie*, 105 F.3d at 1406.

The PTO may refuse to register a trademark that is so similar to a registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause

confusion, or to cause mistake, or to deceive. . . ." 15 U.S.C. § 1052(d) (Supp. 2004). *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973), established a test for determining whether there is a likelihood of confusion:

> In testing for likelihood of confusion . . . the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark). (10) The market interface between applicant and the owner of a prior mark .... (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e.,

> whether *de minimis* or substantial. (13) Any other established fact probative of the effect of use.

Neither we nor the board, however, need consider every *DuPont* factor. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) ( "While it must consider each factor for which it has evidence, the [b]oard may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods."). Instead, we are required only to consider those factors that are relevant. There are three such factors in this case: (1) the alleged fame of Shen's RITZ mark; (2) the similarity of the marks; and (3) the relatedness of the goods.[3] *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002).

Before undertaking a comparison of each set of marks, we address Shen's contention that its RITZ mark is famous and, therefore, entitled to enhanced protection. *See id.* at 1371 (noting that famous marks enjoy greater protection). In support of this argument, Shen offered evidence that: (1) its mark is arbitrary; (2) more than $5 million worth of products bearing Shen's RITZ mark are sold annually; (3) the RITZ mark has been used continuously since 1892; (4) Shen spends hundreds of thousands of dollars annually on advertising; and (5) products bearing Shen's RITZ mark are advertised nationally. *See id.* ("[F]ame of a mark may be measured

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3. We assume that the channels of trade and the sophistication of the purchasers are identical. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002) ("[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.").

indirectly . . . by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident."). This evidence does not, however, justify a finding of fame. In *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569-70 (Fed. Cir. 1983), we found that the GIANT FOOD mark was famous based on its 45 years of use, sales in excess of $1 billion per year, extensive media exposure and prominent display on the facade of supermarkets. Likewise, we found in *Bose*, 293 F.3d at 1372, that the ACOUSTIC WAVE mark was famous based on 17 years of use, annual sales over $50 million, annual advertising in excess of $5 million, and extensive media coverage. Although Shen's RITZ mark has been in use for more than a century, it does not compare in terms of sales, advertising or media interest. Further, it cannot be said that Shen's mark enjoys the "extensive public recognition and renown" characteristic of a famous mark. *Id.* at 1371 (quotation marks omitted). Thus, the board's failure to find that Shen's RITZ mark is famous is supported by substantial evidence.

We now consider each set of marks in turn, beginning with Opposition No. 71,706, which the board dismissed. The two marks at issue are Shen's RITZ for bathroom towels and RHL's PUTTING ON THE RITZ for shower curtains.[4] The board found, and we agree, that bathroom towels and shower curtains are related goods. *Board's Opinion*, slip op.

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4. Although Shen asserts that it now uses its RITZ mark on shower curtains, it did not start this practice until after RHL's application. As such, it is not entitled to priority of use for RITZ on shower curtains. *See Person's Co. v. Christman*, 900 F.2d 1565, 1569 (Fed. Cir. 1990).

at 10. Because the goods are related, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992). As to the marks, the board found that PUTTING ON THE RITZ leaves the consumer with a distinct impression, specifically that of getting dressed up or of the song composed by Irving Berlin. *Board's Opinion*, slip op. at 10. Shen argues that this was error because it overemphasizes the relevance of the words "Putting on the" while simultaneously underemphasizing the use of "Ritz." In this vein, Shen contends that "Putting on the" has no significance aside from its use in conjunction with "Ritz." As such, "Ritz" is the only relevant portion of the mark and, therefore, RHL's mark is identical to Shen's mark.

While there are often discrete terms in marks that are more dominant and, thus, more significant to the assessment of similarity, *Giant Food*, 710 F.2d at 1570 (finding GIANT to be dominant in both marks), the law forbids the type of dissection proposed by Shen. *See Packard Press*, 227 F.3d at 1358 ("The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety."); *see also In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985). PUTTING ON THE RITZ, when evaluated as a whole, conveys a strong commercial impression. It conjures images of fancy, even swanky, ladies in full length gowns and gentlemen in tails and top hats congregating in a large Art Nouveau restaurant where an orchestra is about to start. This image, one of comfort, sophistication and wealth, resonates strongly with the buying public, leaving them with an impression unlike

that from Shen's RITZ mark, which, when used on kitchen textiles, invokes images, if any, of cleaning, cooking or manual labor generally. The two marks also differ in terms of sound and appearance. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1343 (Fed. Cir. 2003). RHL's mark contains other words in addition to "Ritz," making both its visual appearance and pronunciation longer. Thus, we affirm the board's dismissal of Opposition No. 71,706 because the dissimilarity of the marks prevents a likelihood of confusion.

We now turn to Opposition Nos. 73,756 and 74,517, which the board also dismissed. Both of these oppositions challenged the registration of RITZ PARIS RITZ HOTEL and design, which is reproduced here.

The products covered in the first opposition include dinnerware, such as plates, cups, saucers and drinking glasses, in addition to cleaning items, such as steelwool and sponges. The second includes various types of floor coverings, such as carpets and rugs, as well as wall coverings. The board found that despite the relatedness of some of the products listed in the applications (e.g., sponges) to Shen's cleaning

towels, the marks are sufficiently different to avoid a finding of likely confusion. *Board's Opinion*, slip op. at 9. Shen argues that the board erred by giving too much weight to the disclaimed elements of RHL's mark, namely the term "Paris" in large font and the terms "Paris" and "hotel" that appear on the banner under the crest. The disclaimed elements of a mark, however, are relevant to the assessment of similarity. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993). This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed. *In re Nat'l*, 753 F.2d at 1059. Therefore, the board did not err by taking into account the reference in RHL's mark to a hotel in Paris, France.

RHL's mark is further differentiated by the crest and ribbon, which give the mark a particularly regal feel. The crest, ribbon and reference to Paris collectively give the commercial impression of royalty, old-world tradition and continental elegance, which differs from the more mundane impression imparted by Shen's RITZ mark. Aside from the distinct commercial impression left by RHL's mark, the appearance of the mark is also different from Shen's RITZ mark. *See Hewlett-Packard*, 281 F.3d at 1265. Shen's mark generally appears as simple block lettering or block lettering centered in a diamond, as reproduced here.

Thus, Shen's uncomplicated mark either has a different shape, a diamond as opposed to the half circle used by RHL, or no embellishment at all. Based on the differences between the RITZ PARIS RITZ HOTEL and design and RITZ marks, we affirm the dismissal of Opposition Nos. 73,756 and 74,517.

Next, we assess that portion of the board's decision sustaining Opposition No. 72,818, which relates to RHL's registration of RITZ for cooking and wine selection classes. The marks are identical; therefore, we focus our attention on the relatedness of the goods. The board found that RHL's cooking classes are related to Shen's kitchen textiles because "in providing cooking courses . . . it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders." *Board's Opinion*, slip op. at 6. Thus, the board based its finding of relatedness on the fact that "the services of applicant clearly require the use of certain of opposer's goods." *Id.*

That two goods are used together, however, does not, in itself, justify a finding of relatedness. "[T]he test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue . . . can be related in the mind of the consuming public as to the origin of the goods." *Packard Press*, 227 F.3d at 1358. Conversely, goods that are neither used together nor related to one another in kind may still "be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (comparing FRITO-LAY for snack foods to FIDO

LAY for dog treats). Therefore, although a student of RHL's cooking classes would undoubtedly use kitchen textiles, it does not necessarily follow that the consuming public would understand those products to have originated from the same source. For example, in *In re Coors*, 343 F.3d at 1341, we held that the board erred by finding that beer and restaurant services are related regardless of the fact that countless restaurants serve beer. On the other hand, we found that "distributorship services in the field of automotive parts" were related to service station oil and lubrication services. *In re Shell*, 992 F.2d at 1206 (comparing the use of RIGHT-A-WAY on both products). Likewise, we found that amplifiers (i.e., parts of sound systems) were related to complete sound systems. *Bose*, 293 F.3d at 1376 (comparing the use of ACOUSTIC WAVE with POWER WAVE). And, finally, we found that data processing services would be perceived by the purchasing public as related to computer hardware and consultant data processing services. *Packard Press*, 227 F.3d at 1358 (comparing HEWLETT-PACKARD with PACKARD TECHNOLOGIES).

Of these, the relationship between cooking classes and kitchen textiles is more akin to the relationship between restaurant services and beer. Cooking classes are not the same type of product as kitchen textiles: one is a service while the other is a tangible good. Nor are they the same category of product in the sense that snack foods and dog treats are. *See Recot*, 214 F.3d at 1329. In this sense, it would be more accurate to say that cooking classes are in the same category as language or pottery classes. Thus, aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from

the same source. As a result, the board's finding of relatedness is not supported by substantial evidence. Having determined that cooking classes and kitchen textiles are not related, we likewise reverse the ultimate conclusion as to the likelihood of confusion. Although the marks are identical, the differences in the products as well as the weakness of Shen's mark lead us to dismiss Opposition No. 72,818.

Finally, we turn to Opposition No. 75,003 for THE RITZ KIDS, which was sustained by the board. The board found that THE RITZ KIDS was similar to RITZ because "the word THE is one of those words that has virtually no significance in distinguishing trademarks" and "the word KIDS . . . simply indicates that the particular item of apparel is designed for kids." *Board's Decision*, slip op. at 8. The board likewise found that gloves are "legally identical" to barbeque mitts based on the definition in *Random House Webster's Dictionary* (2001) of "mitt" as a type of glove. *Board's Decision*, slip op. at 7. In conclusion, the board commented that, "if a consumer were familiar with opposer's RITZ mitts, we believe that upon encountering applicant's mark THE RITZ KIDS for, among other goods, gloves, he or she would assume that they emanate from a common source." *Id.* at 8.

We cannot sanction the board's dissection of RHL's mark. *See In re Nat'l*, 753 F.2d at 1058 (holding that a "likelihood of confusion cannot be predicated on dissection of a mark"). While it is accurate that terms such as "the" and "kids" often have little impact on consumers, this is not universally true. In this case, for instance, "the" has elevated significance because of the well-known manner in which people refer to RHL as "*The* Ritz" or "*The* Ritz Hotel," but not as "Ritz" or

"Ritz Hotel." *See id.* at 1058-59 ("Without question, the descriptive or generic character of an expression . . . is pertinent to the issue of likelihood of confusion."). Therefore, "the" operates as an indicator of source in RHL's mark even though it has diminished importance in most other marks. And, while "kids" is undeniably used to indicate that the product is geared toward children, it distinguishes RHL's mark from Shen's; it is unlikely that consumers would mistakenly believe that Shen, the manufacturer of kitchen textiles, has expanded into children's clothing. In addition, the pronunciation of THE RITZ KIDS sounds like "The Rich Kids," leaving the impression of wealth, a concept tied strongly to RHL and not associated in any way with Shen's RITZ mark. Thus, taking into consideration the "appearance, sound, connotation, and commercial impression of the two marks," we reverse the board's finding that THE RITZ KIDS is similar to RITZ. *In re Coors*, 343 F.3d at 1343.

We also reverse the board's finding that gloves are related to barbeque mitts because it is not supported by substantial evidence. The mere fact that "mitt" is defined as a type of glove has no relevance to whether a consumer would believe that the two products emanate from the same source. *See Packard Press*, 227 F.3d at 1358. First, Shen's product is not a mitt, it is a *barbeque* mitt. It is designed to protect the hand from heat while cooking. While it covers the hand like a glove, it is better understood as a tool than as an article of clothing. The unrelatedness of RHL's and Shen's products is highlighted by comparing a similar set of goods: hard hats used by construction workers and fedoras. While both are hats that are used to cover the head, they have different purposes. The first is used for protection, just as a barbeque

mitt is, while the second functions to keep the head warm in addition to adding an air of style, just as ready made or tailored gloves do. The mere fact that both barbeque mitts and gloves are worn on the hands simply does not support a finding that consumers would associate these products with a common source. *See Recot*, 214 F.3d at 1329. The board's finding that RHL's and Shen's goods are related is reversed. Because THE RITZ KIDS is not similar to RITZ and gloves are not related to barbeque mitts, we likewise reverse the board's decision sustaining Opposition No. 75,003.

*Conclusion*

Accordingly, we affirm the decision dismissing Opposition Nos. 71,706, 73,756 and 74,517; and reverse the decision sustaining Opposition Nos. 72,818 and 75,003.

*Costs*

No costs.

*AFFIRM-IN-PART AND REVERSE-IN-PART*

## APPENDIX B — OPINION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE DATED AUGUST 7, 2003

Mailed: August 7, 2003

**UNITED STATES PATENT AND TRADEMARK OFFICE**

Trademark Trial and Appeal Board

Shen Manufacturing Company Incorporated v.
Ritz Hotel Limited

Consolidated Opposition Nos. 71,706; 72,817; 72,818; 73,756; 74,517; 74,778; and 75,003

Before Simms, Hanak and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

In 1984 and 1985 the Ritz Hotel Limited (applicant) filed seven applications seeking to register marks consisting of or containing the word RITZ for various goods and services.

Thereafter, Shen Manufacturing Company Incorporated (opposer) filed seven Notices of Opposition alleging that applicant's use of its marks in connection with its goods and services would be likely to cause confusion with opposer's mark RITZ and design which it had used continuously since various dates (the earliest being 1892) for various products. Opposer alleged that all of its uses of RITZ and design long predated any first use dates claimed by applicant.

*Appendix B*

Applicant filed answers which denied that the contemporaneous use of any of its seven marks for their respective goods and services were likely to cause confusion with respect to opposer's mark for its goods. By an order of this Board dated April 25, 2001 the seven oppositions were consolidated. Both parties filed briefs and were present at a hearing held on March 20, 2003.

Applicant has raised numerous evidentiary objections. To a lesser extent, so has opposer. We have reviewed these objections, and have considered only that evidence which is relevant and properly before this Board. However, having said the foregoing, three objections raised by applicant deserve special comment.

First, at pages 15 and 16 of its brief, applicant contends that "Shen [opposer] has offered testimonial deposition testimony and evidence at trial concerning the use of RITZ marks other than those pleaded in the notices of opposition." In its Notices of opposition, opposer made specific reference to its RITZ and design mark, as shown below.

During the course of this proceeding, opposer's counsel (as well as applicant's counsel) repeatedly referred to opposer's mark as RITZ per se, without any mention whatsoever of its diamond design element. Thus, we hold that applicant has waived its objections to opposer's uses of RITZ per se.

However, having said the forgoing, we note that our ruling really constitutes a "distinction without a difference." In essence, opposer pled rights in RITZ surrounded by a very

simple geometric shape, namely, a diamond. It has long been held that such simple geometric background shapes have no trademark significance in that the public rarely takes notice of them. 1 *McCarthy on Trademarks and Unfair Competition*, Section 7:29 at page 7-68.7 (4th ed. 2002). An excellent example of this principle is found in *In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). In finding a likelihood of confusion between applicant's mark BIGG'S TRUE MINIMUM PRICING surrounded by a rectangle for grocery store services and the cited mark BIGG'S surrounded by an oval for furniture, the Court did not even discuss the presence of the rectangle or the oval. Hence, in our likelihood of confusion analysis, we will assume that opposer's mark is essentially RITZ per se.

Second, there is, as pointed out at pages 15 to 17 of applicant's brief, a dispute as to which goods opposer has established prior trademark rights. However, with one exception – shower curtains, to be discussed later – there is no dispute, as applicant acknowledges at page 16 of its brief, that opposer has established prior trademark rights in RITZ for dish cloths, kitchen towels, bathroom towels, toaster covers, textile placemats, napkins, potholders, barbeque mitts, aprons, and cleaning and polishing cloths. For our various likelihood of confusion considerations, the forgoing admission is sufficient, although we should add that the record reflects that opposer has established prior rights in the mark RITZ for a number of other related products.

Third, at footnote 12 at page 18 of its brief, applicant raises for the first time a defense under *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA

1969). Not only did applicant fail to plead a *Morehouse* defense, but said defense was not tried by the explicit or implicit consent of the parties. Hence, we will not consider this defense.

We now turn to the merits of the oppositions. Applicant seeks to register RITZ in typed drawing form for "providing courses of instruction in cooking, meal preparation and wine selection" (Ser. No. 73/499,080, Op. No. 72,818) and for "threads for use in textiles" (Ser. No. 73/549,463, Op. No. 74,778). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1978) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, they are essentially identical. As previously noted, there is no meaningful distinction between RITZ and RITZ enclosed within a simple geometric shape such as a diamond. Thus, the first *Dupont* "factor weighs heavily against applicant" because applicant's mark is essentially identical to opposer's mark. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of opposer's goods and applicant's goods and services, we note that because the marks are essentially identical, their contemporaneous use can lead to the assumption that there is a common source

"even when [the] goods or services are not competitive or intrinsically related." *In re Shell Oil Co.*, 922 F.2d 1204, 26 USPQ 1687, 1689 (Fed. Cir. 1993).

However, in this case, we find that certain of opposer's goods are clearly related to providing courses of instruction in cooking and meal preparation, and threads for use in textiles. Obviously, in providing cooking courses (applicant's services) it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders. After having prepared the food, one would need napkins and placemats. Accordingly, given the fact that the marks are virtually identical and the services of applicant clearly require the use of certain of opposer's goods, we find that there exists a likelihood of confusion.

As for applicant's RITZ threads for use in textiles, even if we make the assumption (not established by applicant) that such threads are only purchased by professional buyers, nevertheless, we find that such professional buyers who are aware of opposer's RITZ dish cloths, kitchen towels, napkins, cleaning cloths, textile placemats, polishing cloths and bathroom towels would assume that both threads for textiles and the finished products emanated from a common source. We recognize that professional buyers of threads for textiles are sophisticated. However, no degree of sophistication would enable even a professional to distinguish between essentially identical marks. Hence, we find that there exists a likelihood of confusion.

As for applicant's application Ser. No. 73/572,795 (Op. No. 75,003) for THE RITZ KIDS in typed drawing form

for, amongst other goods, gloves, we likewise find that there exists a likelihood of confusion with opposer's mark RITZ and simple diamond design. To begin with, we note that applicant's Class 25 application for THE RITZ KIDS includes "gloves" of all types, including ready made and tailored. A "mitt" is defined as a typed of glove. *Random House Webster's Dictionary* (2001). Because the goods are in part legally identical, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698, 1700 (Fed. Cir. 1992). Whether mitts (some of opposer's goods) are related to other of applicant's Class 25 goods is irrelevant for our likelihood of confusion analysis. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). In considering applicant's mark THE RITZ KIDS, we note that the word THE is one of those words that has virtually no significance in distinguishing trademarks. *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). As for the word KIDS, it is clear that this word simply indicates that the particular item of apparel is designed for kids. Accordingly, if a consumer were familiar with opposer's RITZ mitts, we believe that upon encountering applicant's mark THE RITZ KIDS for, among other goods, gloves, he or she would assume that they emanate from a common source. Hence, the opposition is sustained as to applicant's Class 25 goods. Because opposer only opposed the Class 25 goods, it is not sustained as to the other classes. See page 7 of this Board's order of April 25, 2001.

As for applicant's applications to register RITZ PARIS RITZ HOTEL and design shown below for "dinner plates of

porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, household glassware; namely, tumblers, goblets and juice glasses" (Ser. No. 73/518,941, Op. No. 73,756) and for "carpets, rugs, floor mats and matting, linoleum for covering existing floors, wall covering made of vinyl and plastic" (Ser. No. 73/518,946, Op. No. 74,517), we simply note that this mark and opposer's mark are distinctly different in appearance, pronunciation and especially meaning. Put quite simply, applicant's mark conjures up a hotel in Paris, more specifically, the world famous Ritz Hotel. Thus, despite the fact that certain of opposer's goods (cleaning and polishing cloths) and certain of applicant's goods (household sponges and brushes) are very similar in terms of their functions, we nevertheless find that given the significant disparity in the marks, there exists no likelihood of confusion.

We turn now to application Ser. No. 73/514,805 (Op. No. 71,706) for PUTTING ON THE RITZ in typed drawing form for "shower curtains." To begin with, we note that while opposer has now made use of its mark RITZ for shower curtains, said use did not occur prior to applicant's priority date. Hence, the closest goods to shower curtains for which opposer has established priority are bathroom towels. Clearly, bathroom towels and shower curtains are related goods. However, put quite simply, the mark PUTTING ON THE RITZ conjures up images of getting well dressed up, or to older individuals such as myself, the legendary song *Puttin' on the Ritz* composed by Irving Berlin. We find that the differences in the marks outweigh the similarities in the goods (shower curtains and bathroom towels) such that there is no likelihood of confusion.

*Appendix B*

Finally, with regard to applicant's application seeking to register CESAR RITZ (Ser. No. 73/499,264, Op. No. 72,817) for "educational services; namely, conducting courses of instruction in cooking," we find that this mark is dissimilar enough from opposer's mark RITZ such that there is no likelihood of confusion. We recognize that previously we found confusion between opposer's mark RITZ and applicant's mark RITZ for cooking courses. Nevertheless, we find that the presence of CESAR in applicant's mark is sufficient to distinguish it from opposer's mark such that there is no likelihood of confusion. While by no means the dispositive factor, we note that CESAR is the first word in applicant's mark and this is "a matter of some importance since often it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products v. Nice Pak Products*, 9 USPQ2d 1825, 1827 (TTAB 1988) .

Decision: The oppositions are sustained with regard to opposition Nos. 72,818 and 74,778 (RITZ) and Op. No. 75,003 (THE RITZ KIDS). The other four oppositions are dismissed.

## APPENDIX C — REQUEST FOR ORAL HEARING OF THE UNITED STATES PATENT AND TRADEMARK OFFICE DATED OCTOBER 2, 2002

**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**2900 Crystal Drive**
**Arlington, Virginia 22202-3513**

Opposition No. 71,706
Opposition No. 72,817
Opposition No. 72,818
Opposition No. 73,756
Opposition No. 74,517
Opposition No. 74,778
Opposition No. 75,003

Shen Manufacturing Company, Incorporated

v.

Ritz Hotel Limited

**Nancy L. Omelko, Interlocutory Attorney:**

This case now comes up on the following motions:

a. Applicant's contested motion (filed June 28, 2001) for leave to take a testimonial deposition outside of the scheduled testimony period or, in the alternative, to extend applicant's testimony period by thirty (30) days;

b. Opposer's contested motion (filed July 2, 2001) to amend notices of opposition pursuant to Rule 15(a) Federal Rules of Civil Procedure 37 C.F.R. § 2.107;

c. Applicant's contested motion (filed July 30, 2001) to strike portions of opposer's notice of reliance;

d. Applicant's contested objection (filed August 14, 2001) of filing of reply brief submitted in support of opposer's motion to amend;

e. Opposer's contested motion (filed February 12, 2002) to file an over-size reply brief or, in the alternative, motion for extension of time to file a substitute 25-page reply brief; and

f. Opposer's request (filed February 19, 2002) for oral hearing.

We turn first to Applicant's motion for leave to take a testimonial deposition outside of the scheduled testimony period or, in the alternative, to extend applicant's testimony period by thirty days. Applicant contends that because of the prior commitments of applicant's president, who resides in France, applicant's president will not be available for a testimonial deposition during applicant's testimony period; but applicant's president will travel to the United States twelve days after applicant's testimony period is set to close for such deposition.

In response, opposer argues that applicant refused to make its president available for a testimony deposition notice

by opposer for July 29, 1999; and that applicant refused to produce the witness on the basis that applicant's president was a foreigner and not required to submit to federal rules. Furthermore, the Board stated in its last order that "[f]urther delay of this consolidated case by either party will be looked on with disfavor."

The Board has admonished the parties that it will not permit further delays in this consolidated proceeding. Applicant has provided no information that would convince the Board that further delays are warranted. Accordingly, applicant's motion to take the testimony deposition of applicant's president outside applicant's testimony period, or to extend applicant's testimony period, is denied.

We turn next to applicant's objection to opposer's filing of a reply brief in support of opposer's motion to amend. We are construing this motion as a motion to strike opposer's reply brief in support of opposer's motion to amend. Applicant objects on the basis that opposer's reply brief is merely a reiteration of opposer's moving brief. In response, opposer argues that its reply brief "addresses and discloses facts omitted by Applicant in its brief."

We agree with opposer that its reply brief is more than a mere reiteration of opposer's moving brief. As such, applicant's motion to strike opposer's reply brief in support of opposer's motion to amend is denied.

Accordingly, we have considered opposer's arguments set out in its reply brief for the purpose of deciding opposer's motion to amend its notice of opposition.

*Appendix C*

We will now decide the merits of opposer's motion to amend its notice of opposition. Opposer has indicated that the amended notice adds a registration for "substantially the same goods." In response, applicant argues that the motion is untimely and prejudicial to applicant.

Specifically, applicant argues that the motion was filed on the second-to-last day of opposer's testimony period, nearly two years after the registration in question was issued, and more than two months after the Board issued its resumption order.

In reply, opposer argues that the motion is timely and that applicant will not be prejudiced because the proposed amendment does not set forth a new or additional basis for relief; but rather clarifies the matter pleaded. Opposer argues that not only has applicant known about the registration in question, but has also introduced and used the application at a testimony deposition.

Although opposer has referred to its motion to amend as one submitted under Fed. R. Civ. P. 15(a), it is apparent that the motion should rather be made under Fed. R. Civ. P. 15(b), which pertains to amendments to conform to the evidence.

When issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the

result of the trial of these issues. See, for example, Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usollini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. See, for example, *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984).

In as much as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing. *See Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985).

Accordingly, opposer's motion to amend its pleadings is deferred until final hearing.

As for applicant's motion to strike portions of opposer's notice of reliance filed on July 5, 2001, we note that under

the heading of Miscellaneous Matters, in its order dated April 25, 2001, the Board stated, among other things:

> Needless to say, opposer as plaintiff in the oppositions, is responsible for organizing and presenting its record for trial and to be clear what has been or will be submitted as evidence in this consolidated case.

Under "Notice of Reliance" dated July 5, 2001, opposer submitted, among other things, "[f]or the convenience of the Board . . . a single submission of all testimony, exhibits used thereat, and other evidence upon which Opposer relies in these Opposition proceedings, now consolidated. Copies of these documents are provided. . . ."

Applicant has moved to strike portions of this notice of reliance, namely Exhibits 1 through 7 of opposer's notice of reliance dated July 5, 2001, arguing that these exhibits are testimony depositions and, as such, are not proper subject matter for a notice of reliance, but must be submitted in accordance with Trademark Rule 2.123.

Opposer argues that the motion is meritless since the testimony has already been introduced into the evidentiary record prior to the filing date of opposer's July 5, 2001 notice of reliance; and that the July 5, 2001 submission which contained the testimony depositions submitted as exhibits 1 through 7 of opposer's three volume evidentiary compilation were included for the convenience of the Board. Applicant, in its reply, indicates that the key issue is whether there is any procedural basis for opposer to file testimonial deposition transcripts via a notice of reliance.

*Appendix C*

Trademark Rule 2.125(c) requires that a copy of the transcript and any exhibits thereto shall be filed with the Board. The standard has been a flexible one and, as a practical matter, has meant that a transcript and any exhibits thereto are considered to have been promptly filed if they are submitted at any time prior to the final hearing of the case by the Board. *See Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390 (TTAB 1991).

Furthermore, we note that the prosecution histories entered in the physical file for certain cases in this consolidated proceeding indicate the following with respect to opposer's exhibits 1 through 7 of its notice of reliance:

1. Exhibit 1 has been entered in the prosecution history of Opposition No. 71,706 as No. 13, showing a date of June 23, 1986, for "testimony of plaintiff";

2. Exhibit 2 has been entered in the prosecution history of Opposition No. 72,817 as No. 17, showing a date of September 8, 1986, for "testimony for plaintiff of Howard Steidle";

3. Exhibit 3 has been entered in the prosecution history of Opposition No. 72,817 as No. 81, showing a date of September 20, 1999, for "testimony of Robert Steidle";

4. Exhibit 4 has been entered in the prosecution history of Opposition No. 73,756 as No. 52, showing a date of September 20, 1999, for "continued oral dep of Robert M. Steidle";

5. Exhibit 5 has been entered in the prosecution history of Opposition No. 74,517 as No. 58, showing a date of September 20, 1999, for "testimony of Howard Steidle"; and

6. Exhibit 6 has been entered in the prosecution history of Opposition No. 72,817 as No. 59, showing a date of September 20, 1999, for "testimony of Robert Steidle".

Opposer indicates that with respect to Exhibit 7, "Applicant's counsel attended Mr. Steidle's September 1, 1999 testimony deposition and cross-examined Mr. Steidle. While the transcript of Mr. Steidle's September 1, 1999 testimony deposition does not appear as an entry in the prosecution history, Thomas G. Oakes Association confirms and certifies that said transcript was timely mailed to the Board for filing in opposition no. 71,706. Opposer has attached the declaration of Thomas Oakes.

Inasmuch as opposer has established that Exhibits 1 through 7 were properly filed with the Board; and that the documents filed under notice of reliance dated July 5, 2001 were merely resubmissions, applicant motion to strike exhibits 1 through 7 is denied.

Turning now to opposer's motion to file a reply brief that exceeds the page limit set forth in Trademark Rule 2.128, we note that the motion has been fully-briefed by the parties. Further, the Board notes that applicant filed its brief on the case after its time closed for filing its brief; and opposer filed its reply brief after its time closed for filing its reply brief.

Neither party has objected, and thus has waived any right to object, to the late filing of these briefs and, therefore, they are considered of record. Furthermore, at this late date, the Board will not permit the filing of a motion to strike either brief as untimely.

Opposer maintains that this consolidated proceeding is complicated because it involves six different trademarks used in connection with seven different identifications of goods. Opposer further maintains that applicant, in its brief, included fourteen pages devoted to evidentiary objections, which opposer must also respond to.

In response, applicant argues that the although the proceeding has been going on for a considerable length of time, "both parties were more than able to discuss their arguments in full in their principal briefs within the prescribed page limits" and "[a]pplicant's objections to some of the evidence fall within a limited range of conceptual categories and do not require a lengthy, point-by-point response."

Applicant further argues that opposer includes objections to various items of evidence offered by applicant, which opposer did not object to in opposer's principal brief; and opposer includes new issues, such as discussions of reverse confusion, and that applicant did not file its application in good faith. Applicant does not object to opposer's motion to file a substitute reply brief.

Opposer replies, to add, among other things, that opposer's evidentiary objections were properly made and

timely proffered and opposer further contends that it introduced no new issues, but merely rebutted applicant's arguments in applicant's brief.

It is the view of the Board that opposer has not shown good cause for exceeding the twenty-five page limit in its reply brief. Accordingly, opposer's motion to file a brief that exceeds the page limit set forth in Trademark Rule 2.128 is denied; and opposer is allowed until **fifteen days** from the date of this order to file a reply brief that complies with Trademark Rule 2.128.

The request for oral hearing is noted. An oral hearing will be scheduled in due course.

## APPENDIX D — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED MARCH 8, 2005

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

04-1063, -1076
(Opposition Nos. 71,706, 72,817, 73,756, 74,517, 72,818, and 75,003)

SHEN MANUFACTURING CO., INC.,

Appellant,

v.

THE RITZ HOTEL LIMITED,

Cross Appellant.

**ORDER**

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

*Appendix D*

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on March 15, 2005.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: March 8, 2005

## APPENDIX E — RELEVANT STATUTES

### 5 U.S.C. § 706

**Section 706. Scope of review**

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

## 15 U.S.C. § 1052

**Section 1052. Trademarks registrable on principal register; concurrent registration**

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods

and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of Title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be

issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this

title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

*Appendix E*

## 15 U.S.C. § 1063

### Section 1063. Opposition to registration

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be

issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

**Table I**

**Summary of Oppositions**

| Opp. No. | Applicant's Mark | Applicant's Goods/Services | App/n. Filing Date | Sec. 44 | Sec. 44 Date | Date of First Use |
|---|---|---|---|---|---|---|
| 71,706 | PUTTING ON THE RITZ<br>JA000022.008<br>JA000022.151 | IC 24. US 42. Shower curtains. | 73/514,805 | 12/21/84 | No | - 05/01/84 |
| 72,817 | CESAR RITZ<br>JA000022.171<br>JA000022.035 | IC 41. US 107. Educational services; namely, conducting courses of instruction in cooking. | 73/499,264 | 09/13/84 | Yes | 04/17/80 |
| 72,828 | RITZ<br>JA000022.060<br>JA000022.193 | IC 41. US 107. Providing courses of instruction in cooking, meal preparation, and wine selection. | 73/499,080 | 09/12/84 | Yes | 05/04/84 |

-

| Opp. No. | Applicant's Mark | Applicant's Goods/Services | | App/n. Filing Date | Sec. 44 | Sec. 44 Date | Date of First Use |
|---|---|---|---|---|---|---|---|
| 73,756 | RITZ PARIS<br>RITZ HOTEL<br>JA000022.083<br>JA000022.215 | IC 21. US 2, 29,4,30,33,40. Dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steel wool, household glassware; namely, tumblers, goblets and juice glasses. | 73/518,941 | 01/23/85 | Yes | 09/07/84 | |
| 74,517 | RITZ PARIS<br>RITZ HOTEL<br>JA000022.104<br>JA000022.233 | IC 27. US 20, 42. Carpets, rugs, floor mats and matting, linoleum for covering existing floors, wall coverings made of vinyl and plastic. | 73/518,946 | 01/23/85 | Yes | 09/21/84 | - |

| Opp. No. | Applicant's Mark | Applicant's Goods/Services | | App/n. Filing Date | Sec. 44 | Sec. 44 Date | Date of First Use |
|---|---|---|---|---|---|---|---|
| 75,003 | THE RITZ KIDS<br>JA000022.125<br>JA000022.269 | IC 33. US 47, 49.<br>Wine, champagne, brandy, cognac and armagnac.<br><br>IC 25. US 39.<br>Ready made and tailored clothing; namely, underwear, dresses, skirts, trousers, shirts, neckties, belts, gloves, hats, tights, boots, shoes and slippers for men, women and children, and waterproof clothing; namely, men's and women's raincoats, rain hats and galoshes.<br><br>IC 29. US 46.<br>Meat, poultry, meat extracts, fresh frozen fruits and vegetables, fruit preserves, edible oils, pickles, and frozen entrees consisting of meat, fish, poultry or game. | 73/572,795 | 12/10/85 | Yes | 06/17/85 | - |

*Appendix G*

**Appendix Table IIa**

**Shen's RITZ Marks Under Common Law**

| | |
|---|---|
| RITZ | RITZ and Design |
| RITZ PRO SERIES | RITZ ESSENTIALS |
| RITZ STERLING | RITZ ROYALE |
| RITZ SUPREME | RITZ CLASSICS |
| RITZ DESIGN LINE | (JA465-72) |

*Appendix G*

**Appendix Table IIb**

**List of Shen's Goods (Non-Exhaustive) Sold in U.S. Commerce Under its RITZ Marks**

(JA61, 70, 71, 72, 114, 115, 116, 121, 122, 123, 124, 456-494, 561)

appliance covers
anti-microbial cloth
aprons
bath towels
bathroom scrubbing cloths
beach towels
baker's pad
baker's mitt
baker's glove
baker's arm sleeve
baker's towel
bar mop towels
cheese cloth
cook's towel
chef's hat
chef's cap
chef's jacket
chef's skillet handle
cut resistant kitchen glove
cleaning cloths
dish cloths
dish towels
dust cloths
flour sack towels
hand towels
glass towels
ironing board covers
laundry bag
kitchen towels
napkins
oven mitts
place mats
polishing cloths
pot holders
scouring cloths
seat cushions
shower curtains
table cloths
tile cloths
tub mats
wash bag
wash cloths
window cloths

*Appendix F*

| Opp. No. | Applicant's Mark | Applicant's Goods/Services | App/n. Filing Date | Sec. 44 | Sec. 44 Date | Date of First Use |
|---|---|---|---|---|---|---|
| | | IC 16. US 37, 38.<br>Writing paper and envelopes, pens, pencils, engagement books, file folders, blotter holders and playing cards. | | | | |
| | | IC 14. US 27.<br>Watches, clocks and parts thereof. | | | | |

**Table II**

**Shen's Ritz Marks**

| MARK | REGISTRATION NO. | GOODS/SERVICES |
|---|---|---|
| RITZ and design JA000022.216 | 1,360,630 | IC 24. US 42. Dish cloths, kitchen towels, toaster covers, textile place mats, napkins, potholders and barbeque mitts. |
| RITZ and design JA000022.161 | 125,512 | US 4. Cleaning and polishing cloths, abrasive, detergent and polishing materials. |
| RITZ and design JA000022.159 | 1,231,981 | IC 25. US 39. Aprons. |
| RITZ JA000022.157 | 2,288,326 | IC 22 and 24, US 1,2,7,19,22,42 and 50. Laundry bags and Clothespin bags. Dish cloths, kitchen towels, bathroom towels, ironing board pads and covers, toaster covers, place mats, napkins, pot holders, oven mitts, and barbeque mitts. |